



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FOLEY & LARDNER LLP
150 EAST GILMAN STREET
P.O. BOX 1497
MADISON WI 53701-1497

MAILED

DEC 02 2010

OFFICE OF PETITIONS

In re Application of :
Malek :
Application No. 10/722,119 : ON APPLICATION FOR
Filed: November 25, 2003 : PATENT TERM ADJUSTMENT
Docket No. 036163-0103 :

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR PATENT APPLICATION UNDER 37 C.F.R.

§ 1.705(b), filed September 29, 2010. Applicant submits that the patent term adjustment to be indicated on the patent is two thousand one hundred forty-eight (2148) days, not eight hundred ninety-six (896) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction partly on the basis that the Office will take in excess of three years to issue this patent.

In addition, in accordance with applicant's duty of candor and good faith before the Office, applicant discloses that applicant's calculation of the adjustment for the Office's failure to respond to the amendment filed on June 2, 2008 within 4 months differs from the Office's calculation.

To the extent that applicant requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or

applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that he may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

To the extent that applicant otherwise requests correction of the initial determination of patent term adjustment (PTA), the application for patent term adjustment is **DISMISSED**.

On June 30, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 896 days.

¹ For example, if an applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

In accordance with applicant's duty of candor and good faith before the Office, applicant discloses that applicant's calculation of the adjustment for the Office's failure to respond to the amendment filed on June 2, 2008 within 4 months differs from the Office's calculation. Applicant asserts that the Office should have entered a period of adjustment of 31 days, rather than 97 days, for the delay associated with responding to the June 2, 2008 amendment. On June 2, 2008 applicant filed an amendment after final. On August 26, 2008 applicant filed a notice of appeal and a request for pre-appeal conference. On September 25, 2008, the Office mailed a Notice of Panel Decision from Pre-Appeal Brief Review that stated the rejection was withdrawn and a new Office action would be mailed. On January 7, 2009, the Office mailed an Office action.

Given the decision by the panel, applicant was properly accorded 97 days for Office delay in mailing an Office action after the June 2, 2008 amendment. Since the rejection was withdrawn, the amendment filed June 2, 2008 was treated as stopping the § 704(b) clock. Pursuant to 37 CFR 1.702(a)(2), the proper calculation is from the day after four months after June 2, 2008, October 3, 2008, to the date the Office action was mailed, January 7, 2009. Therefore, the 97 day adjustment for Office delay in responding to the June 4, 2008 amendment is proper and no change in the 97 day adjustment is warranted.

In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance remains 896 days -- 925 days of Office delay minus 29 days of Applicant delay.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b). This fee is required and will not be refunded.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley
Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions